

REMARKS

Claims 108-117, 124-125, 151-155, 157, and 176-183 were pending and stand rejected. Applicants thank the Examiner for examination of the claims pending in this application.

In view of the Amendments herein and the Remarks that follow, Applicants respectfully request withdrawal of the finality of the rejection, and reconsideration and withdrawal of all outstanding objections and rejections.

Interview Summary

Applicants thank the Examiner for the informal conversation on October 15, 2008, during which the asserted basis for the improper final rejection was raised, as also indicated in the Fax requested by the Examiner (dated October 15, 2008), during which Applicants believed agreement had been reached on the issue as the Examiner had indicated that he was likely to issue a new action as a result of the believed agreement. However, the Interview Summary of October 31, 2008 followed instead.

Improper Final

Section MPEP 707.07(d) states, under “Improperly Expressed Rejections,” “A plurality of claims should never be grouped together in a common rejection, unless that rejection is **equally applicable** to all claims in the group” (emphasis added). Because claim 176 includes limitations not addressed in the rejection of claims 108-117, 124-125, the rejection of those claims cannot be “equally applicable” to claims 176-183.

The unaddressed claim limitations are shown below, the comparison copied from the Amendment dated July 24, 2008. Underlined portions represent portions of claim 176 finding no counterpart in claims 108-117, 124-125.

CLAIM 108	CLAIM 176
<p>A method in a client system for ordering an item, the method comprising:</p> <ul style="list-style-type: none"> receiving from a server system a client identifier of the client system; persistently storing the client identifier at the client system; when an item is to be ordered, displaying information identifying the item and displaying an indication of a single action that is to be performed to order the identified item; and in response to the single action being performed, sending to the server system a request to order the identified item along with the client identifier, the client identifier identifying account information previously supplied by a user of the client system wherein the user does not need to log in to the server system when ordering the item; and when account information is to be changed, coordinating the log in of the user to the server 	<p>A method in a computer for ordering an item, the method comprising:</p> <ul style="list-style-type: none"> providing to a client system a client identifier for the client system, the client identifier being associated with account information of a user and for persistent storage at the client system; when an item is to be ordered, providing to the client system a display page identifying an item, the display page including an indication of a single action that is to be performed to order the identified item; receiving from the client system an indication that the user performed the single action along with the client identifier; and <u>generating an order for the identified item using the account information associated with the received client identifier</u> wherein the user does not need to log in to the computer system to order the item; and when account information is to be

<p>system; receiving updated account information; and sending the updated account information to the server system whereby the user does not need to log in to the server system when ordering the item, but needs to log in to the server system when changing previously supplied account information.</p>	<p>changed, coordinating the log in of the user to the computer system; receiving from the client system updated account information; and <u>updating the account information associated with the client identifier of the logged in user based on the received updated account information.</u></p>
---	--

The 10/31/2008 Interview Summary, attempts to “clarify the rejection” of claim 176 and other claims, and **for the first time indicates** sections of the Kirsch reference as the basis for the rejection of claim 176. The Interview Summary also asserts that there is no “new ground of rejection” since all independent claims were rejected under section 102. However, the Interview Summary is the **first time** in which rejection of the “generating and order...” and “updating the account information...” steps of claim 176 in view of Kirsch has been presented. This is improper.

Claim 176 was previously rejected in view of other art (Joseph and Teper), and thus this 102 rejection in view of Kirsch is in fact **a new ground of rejection for this claim**. MPEP 706.07(a) states that an action cannot be made final “where the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims....Furthermore, a second or any subsequent action ... will not be made final if it includes a rejection, on newly cited art, ... **of any claim** ... in spite of the fact that other claims may have been amended to require newly cited art.” Thus, Applicants assert that this is a new basis of rejection for **this claim** (claim 176).

Applicants submit that because not all limitations of the pending claims were addressed in the Final Office Action, these errors substantially affect Applicants' ability to properly reply to the Final Office Action or to proceed to appeal per MPEP 710.06. Applicants cannot properly respond to rejections of limitations when those rejections are not expressed. Thus, Applicants request withdrawal of the finality of the action.

Response to Rejection Under 35 USC §112, Paragraph 1

Claims 117, 156, and 183 were rejected under 35 USC §112, ¶1 as allegedly lacking written description. Because claim 155 addresses the subject matter of the rejection and because claim 156 was cancelled, Applicants have addressed the rejection as regarding claim 155. This rejection is respectfully traversed.

The Office Action argues that the specification "does not reasonably prove enablement for a one click order utilizing a shopping cart model." Office Action, p. 3. Applicants have amended claims 117, 155, and 183 to recite "in response to determining that single-action ordering is disabled, providing a shopping cart model that may be used to order the item." Support for these amendments is found in the Specification, e.g., at p. 6, ll. 24-28.

Therefore, Applicants maintain that claims 117, 155 and 183 have adequate written description in the specification as originally filed and withdrawal of the rejection is requested.

Response to Rejection Under 35 USC §112, Paragraph 2

In the Final Office Action claims 108, 113, 117, 154, 155, 176, 180, and 183 were rejected under 35 USC §112, ¶2 as allegedly not specifically pointing out and distinctly

claiming the subject matter that the Applicants regard as the invention, for the use of “when” and “alternatively” in these claims.

Applicants have amended claims 108, 113, 117, 154, 155, 176, 180, and 183 to remove the rejected terms. Support for these amendments is found in the Specification at pp. 6-7.

This amendment has been made to improve readability of the claims, and does not narrow the scope of protection with respect to the prior art.

Thus, Applicants submit that claims 108, 113, 117, 154, 155, 176, 180, and 183 now are recited with sufficient particularity to be patentable and withdrawal of the rejection is requested.

Response to Rejection Under 35 USC §102(e)

Claims 108-112 and 117 were rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 5,963,915 (“Kirsch”). This rejection is now traversed.

Claim 108, as amended, recites:

A method in a client system for ordering an item, the method comprising:

- receiving from a server system a client identifier of the client system;
- persistently storing the client identifier at the client system;
- for an item to be ordered:
 - providing for display information identifying the item and an indication of a single action that is to be performed to order the identified item; and
 - in response to the single action being performed, sending to the server system a request to order the identified item along with the client identifier without a user having to log in to the server system, the request to order being an order indicated by the single action and the client identifier

identifying account information previously supplied by
the user of the client system; and
responsive to changing account information:
coordinating the log in of the user to the server system;
receiving updated account information; and
sending the updated account information to the server system.

Kirsch does not show “sending to the server system a request to order the identified item along with the client identifier without a user having to log in to the server system, the request to order being an order indicated by the single action.” First, Kirsch teaches an ordering method that requires two explicit steps. Kirsch teaches “providing for a purchase transaction that appears to the client user as a singular selection of a purchasable product or service **and** a singular confirmation of the purchase.” Kirsch, col. 4, ll. 48-51 (emphasis added). Kirsch teaches that after “cookie data” is sent to the server, “the purchase of the product or service identified . . . can be presented to the client user for approval using a purchase confirmation form.” Kirsch, col. 8, ll. 27-30. Therefore, Kirsch teaches the selection and confirmation of a purchase as two *distinct* steps. Thus, Kirsch does not disclose “the request to order the identified item being an order indicated by **the single action.**”

Kirsch also does not show “responsive to changing account information: coordinating the log in of the user to the server system.” Kirsch merely discloses an additional verification step after a purchase acceptance has been given by the client user. Kirsch, col. 14, ll. 44-47. This verification step utilizes a PIN maintained by the server to be matched against the client record in order to provide a greater degree of authentication. Kirsch, col. 14, ll. 47-53. However, this is not “coordinating the log in of the user to the server system” because Kirsch discloses a PIN that is separate from the login and password used to log into

the server system. Kirsch, col. 6, ll. 30-34. Applicants note that this separate PIN verification is optional and used if a specific server requires a PIN for all purchases, and that an order is not processed without a valid PIN. Kirsch, col. 14, ll. 47-53. Thus, Kirsch does not disclose “responsive to changing account information: coordinating the log in of the user.”

Claims 151 and 176 are rejected on the “same rationale.” As indicated above, claim 176 serves as the basis for an improper final rejection. However, claims 151 and 176 also recite similar limitations from the client and server systems perspective, including “receiving from the client an indication that the user performed the single action along with the client identifier” and “responsive to changing account information: coordinating the log in of the user to the computer system.” Therefore, claims 151 and 176 are also distinguishable over Kirsch for at least the reasons discussed above.

Claims 109-117, 124-125, 152-155, 157, and 177-183 respectfully depend from claims 108, 151 and 176, shown above to be patentable over the cited reference and which recite additional features not shown in the cited references. In addition, Applicants note that claim 124, as previously presented, recites “**displaying**” which is a positive recitation of a functional feature. For these reasons, Applicants submit that claims 109-117, 124-125, 152-155, 157, and 177-183 also are patentably distinguishable over Kirsch.

Response to Rejection Under 35 USC §103(a)

In the Office Action, claims 113-116 and 124-125 have been rejected under 35 USC §103(a) as allegedly being unpatentable over Kirsch in view of U.S. Patent No. 5,960,411 (“Hartman”), and claims 151-157 and 176-183 are rejected as allegedly containing similar

features as those addressed above and are rejected for the same rationale. These rejections now are traversed.

With respect to claims 113-116 and 124-125, the Office Action relies upon Hartman '411. Applicants respectfully submit that use of the Hartman reference is improper as a basis of a section 103 rejection. The Hartman reference is a reference commonly owned by the assignee of the present application at the time the claimed invention was made, and from which this application claims priority. As indicated in the Preliminary Amendment (dated May 25, 1999) submitted with the application as filed, this application is a continuation of 08/928,951, now issued as Hartman '411. Thus, the Hartman reference is not prior art under § 102 (a), (b), (c), (d), (e), (f), or (g).

Thus, the deficient disclosures of these references, considered either alone or in combination, thus fail to establish even a *prima facie* basis from which a proper determination of obviousness under 35 U.S.C. §103(a) can be made. A *prima facie* showing of obviousness requires (1) some suggestion or motivation to modify the reference, (2) a reasonable expectation of success, and (3) that the reference(s) teach or suggest all the claim limitations. As discussed above, Kirsch does not teach or suggest all of the claimed limitations. Thus, Applicants submit that claims 108, 151, and 176 are patentably distinguishable over the cited references.

Claims 109-117, 124-125, 152-155, 157, and 177-183 respectfully depend from claims 108, 151 and 176, shown above to be patentable over the cited reference and which recite additional features not shown in the cited references. For these reasons, Applicants submit that claims 109-117, 124-125, 152-155, 157, and 177-183 also are patentably distinguishable over Kirsch.

Official Notice

In addition, it is again noted that several facts relied upon in the rejection are based on Official Notice. Some aspects are repetitive from prior recitations of Official Notice, which were seasonably traversed in the prior response. In addition, it appears that Official Notice of new aspects of the claimed invention have also been made in the Final Office Action.

Official Notice unsupported by documentary evidence may be taken where the officially noticed facts are “capable of instant and unquestionable demonstration as being well known.” In this case, Official Notice was taken for the limitations of “displaying partial information” and “including general information that was considered informative to the user” (Office Action, p. 7-8), which are not “capable of instant and unquestionable demonstration as being well known.” Applicants continue to **traverse** the Official Notice as improper as no documentary evidence has been provided and no officially noticed facts have been identified as “capable of instant and unquestionable demonstration as being well known.” On this basis, Applicants challenge the assertions of officially noticed facts and again **request that documentary evidence be produced to support for these statements**, or in the alternative, withdraw all rejections that are based in any way on the facts officially noticed. Applicants do not admit any of the officially noticed facts and reserve the right to argue against these assertions at a later time, if necessary.

Conclusion

In sum, Applicants respectfully submit that claims 108-117, 124, 125, 151-155, 157, and 176-183, are patentably distinguishable over the cited references. Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them. Applicants also request withdrawal of the finality of the rejection.

In addition, Applicants respectfully invite the Examiner to contact Applicants' representative at the number provided below if the Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,

Date: December 29, 2008

By: /Jennifer R. Bush/
Attorneys for Assignee
Jennifer R. Bush, Reg. No. 50,784
FENWICK & WEST LLP
801 California Street
Mountain View, CA 94041
Phone: (650) 335-7213
Fax: (650) 938-5200